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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/460,920	12/14/1999	BETH ANNE PIPER	LA0046A	3115

23914 7590 07/16/2002

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EXAMINER

COOK, REBECCA

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 07/16/2002

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/460,920

Applicant(s)
Piper

Examiner
Rebecca Cook

Art Unit
1614



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 17, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37, 45-54, 58-60, and 71-79 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37, 45-54, 58-60, and 71-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 17, 21 6) ☐ Other:

Art Unit: 1614

The request filed on 6/17/02 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/460,920 is acceptable and a CPA has been established. An action on the CPA follows.

In view of the claim amendments and cancellations, the earlier rejections under 35 U.S.C. 112, second paragraph are overcome.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37, 45-54, 58-60, 71-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Press Release 9/30/99: Bristol-Myers Squibb Files NDA for Novel Oral Antidiabetic Drug (PR) in view of Earle et al¹⁹⁹⁹ for the reasons given in Paper No. 6. Applicant's argument that Earle et al does not contemplate the instant doses of glyburide and metformin is not persuasive. The dose of glyburide is within the limits of claim 37 and in the absence of a showing of unexpected results in Declaration form no unobviousness is seen in the instant 750 mg of metformin over the 800 mg of metformin in Earle et al.

Claims 37, 45-54, 58-60, 71-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hermann et al¹⁹⁹⁴ alone or in view of 6,303,146.

Art Unit: 1614

Hermann et al (abstract, Table 1, among others) disclose a method for first line treatment of type 2 diabetes in a drug naive human patient comprising administering a low dose combination of metformin and glyburide. Dependent instant claims differ over Hermann et al in requiring specific particle sizes of glyburide and regimens and dosages. However, once a method of use is known it is within the skill of the artisan to determine the optimum dosages and regimens. Furthermore, 6,303,146 (claims, among others) discloses the instant particle sizes.


It is noted that a terminal disclaimer over 09/432,465 has not yet been filed.

WO 00/03742 could not be considered because it was not received. Paul was considered to the extent of its English language abstract.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cook whose telephone number is (703) 308-4724. The examiner can normally be reached on Monday through Friday from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


REBECCA COOK
PRIMARY EXAMINER
GROUP 1200

July 15, 2002